REMARKS

No amendments to the pending claims are presented by way of the instant response. Claims 2, 8, 10, 15, 17, and 20 have been withdrawn from consideration pursuant to the May 26, 2006 Office Action. Claims 1, 3-7, 9, 11-14, 16, and 18-19 remain pending in the instant Application and are presented for the Examiner's review in light of the following comments.

Rejection Under 35 U.S.C. §103

Claims 1, 3-7, 9, 11-14, 16, and 18-19 have been finally rejected under 35 U.S.C. §103(a) over McCay, et al., U.S. Patent No. 4,506,575 in view of Watanabe, et al., U.S. Patent No. 4,821,971. Previous arguments made with regard to the *McCay* reference remain in effect but will not be repeated for the sake of brevity. Additionally, the Examiner is respectfully urged to consider the following additional matters that distinguish Applicants' invention, as now presented, over the cited prior art.

1. Applicants' Claims 1, 9, and 16 claim an apparatus for slabbing a roll of material comprising, *inter alia,* a transport element integral with the apparatus that is capable of engaging or engages the roll and conveys the roll to a slabbing position.

2. The Examiner contends that the *McCay* reference lacks an integral transport element. Applicants concur with the Examiner in this regard. In fact, the *McCay* reference fails to even remotely suggest such an integral transport element.

3. The *Watanabe* reference, while disclosing the presence of a "truck 6, conveyor, or the like, and which supports and rotates the paper roll on its axis . . ." does not disclose or suggest that the truck 6, conveyor, or the like is **integral** with the disclosed apparatus.

It is well settled Federal Circuit case law that in order to maintain a rejection under 35 U.S.C. §103(a), cited prior references must teach, disclose, or suggest each and every element of Applicants' claimed invention. ". . . [T]he claimed invention must be considered as a whole, multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure." *See In re Paulsen,* 30 F.3d 1475, 31 U.S.P.Q. 2d 1671 (Fed. Cir. 1994). Assuming, *arguendo,* that even if all the limitations of the present invention

could be found in the total set of elements contained in the prior art references (including Applicants' claimed integral transport unit), "a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention." *See National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 69 U.S.P.Q. 2d 1641 (Fed. Cir. 2004). Likewise, the "determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the [present] invention." *See ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 U.S.P.Q. 2d 1321 (Fed. Cir. 1998).

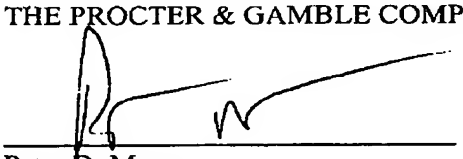
In light of the above, Applicants respectfully submit that the current combination of references presented presents the *prima facie* case of impermissible hindsight. The fact that the cited secondary reference alludes to the fact that a paper roll is transported by a truck 6, conveyor, or the like (without any indication that the truck 6, conveyor, or the like is integral with the disclosed apparatus) leads to this conclusion. Further, since it is clear that the *McCay* reference is silent with respect to an integral transport element, it is difficult to envisage how such a truck 6, conveyor, or the like, as disclosed by the *Watanabe* reference, could be made integral with the cantilevered apparatus of the *McCay* reference. In sum, the *McCay* and *Watanabe* references fail to disclose, teach, suggest, or render obvious, either singly or in combination, every recited feature of Applicants' Claims 1, 9, and 16 and all claims dependent directly or indirectly thereon. Applicants therefore request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection over the *McCay* and *Watanabe* references.

Conclusion

Based on the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512, and no fee is believed due. However, if any additional charges are due, the Examiner is hereby authorized to deduct such charge from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,
THE PROCTER & GAMBLE COMPANY

By: 

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November 27, 2006
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